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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,224	01/16/2002	Reinhold Schopf	DT-6040	6388

30377 7590 05/30/2003

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EXAMINER

COHEN, AMY R

ART UNIT PAPER NUMBER

2859

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/050,224

Applicant(s)

SCHOPF ET AL.

Examiner

Amy R Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by McMurtry (U. S. Patent No. 4,301,338).

McMurtry teaches a stylus (3) comprising a stem (20); and a coating (27) formed of one of an elastically deformable synthetic material and a plastically deformable synthetic material (Col 3, lines 39-45) and covering at least part of the stem (Fig. 1).

McMurtry teaches the stylus wherein the stem is formed as a one-piece member (Fig. 1).

McMurtry teaches a coordinate-measuring apparatus (1), comprising a touch probe (14), and a stylus (3) connectable to the touch probe and including a stem (20) covered, at least partially, by a coating (27) formed of one of an elastically deformable synthetic material and a plastically deformable synthetic material (Col 3, lines 39-45 and Fig. 1).

McMurtry teaches the stylus wherein the stem has means for connecting (Col 2, lines 30-40 and Col 3, lines 18-22) the stem with a touch probe (14), and wherein the breaking point is spaced from the connecting means (Fig. 1).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMurtry in view of Eitel (U. S. Patent No. 3,056,867).

McMurtry discloses the stylus as described above in paragraph 2.

McMurtry does not disclose a stylus wherein the coating is specifically a shrink sleeve or impact-resistant material.

Eitel teaches the stylus wherein the coating is formed as a shrink sleeve that is put on the stem (Col 2, lines 60-63).

Eitel teaches the stylus wherein the one of an elastically deformable synthetic material and a plastically deformable synthetic material is an impact-resistant material (Col 2, lines 59-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the stylus of McMurtry to have the coating formed as a shrink sleeve and to be impact-resistant, as taught by Eitel, so that the coating would have a more secure fit on the stem and so that it would not break or damage upon impact.

Response to Arguments

5. Applicant's arguments filed 12 May 2003 have been fully considered but they are not persuasive.

Regarding the breaking point as claimed in claim 1, Examiner contends that the spigot (24) of McMurtry would in fact be a breaking point if excessive force were applied since it is a

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point of connection and since it appears to be a pivotal connection, Fig. 1. Furthermore, the breaking point/spigot is in fact part of the stem, as it is the end part of the stem.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patent publication and patents disclose probes with breaking points Schopf (PG Pub. US 2002/0066198), Bienhaus et al. (U. S. Patent No. 6,258,531), Kendall (U. S. Patent No. 4,826,372), and Wollar et al. (U. S. Patent No. 4,556,351).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R Cohen whose telephone number is (703) 305-4972. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.

ARC
May 28, 2003



Diego Gutierrez
Supervisory Examiner
Tech Center 2800